

### Remarks

The specification has been amended as suggested by the Examiner. However, if any questions remain, she is invited to call the undersigned.

As to the fact of sale of the plant of the application in a foreign country more than one year prior to the filing date of the application, Section 102(b) specifies that as a condition for patentability “a person shall be entitled to a patent unless--...(b) the invention was ...in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” (emphasis added) The statute does not provide for giving any relevance to the sale of an invention in a foreign country prior to the filing of the U.S. application. Thus, the fact that the rose plant of the application was on sale in a foreign country more than one year before the subject application was filed, is of no relevance to the patentability of the plant.

Moreover, the fact that the description of the rose plant ‘KORpancom’ was published in a plant breeders rights applications in various foreign countries is irrelevant to the patentability of the ‘KORpancom’ rose plant in the United States. The Court in *In re LeGrice*, 301 Fed. 2<sup>nd</sup> 929, 939 (1962) noted that “the proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under Section 102(b).”

That the incapability of recreating by sexual propagation the plants of the applications on appeal in *LeGrice* was the significant point is clear from the following statement: “While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such

general publications as are here involved, cannot be relied upon as a statutory bar under Section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics<sup>1</sup> which one skilled in this art will be presumed to possess.” 301 F.2d @ 939.

The requirement in the patent law for an enabling disclosure is to secure consideration from the inventor for the grant of the patent on his invention. In return for the patent, the applicant is required to provide a disclosure adequate for the skilled in the art to make the patented invention after the patent expires. However, in the drafting of the original plant patent legislation it was recognized that the rebreeding of a plant was at that time impossible (as it is now) and thus Section 162 simply requires “the description is as complete as is reasonably possible.”

An early pioneer in the plant patent field, Harry C. Robb, made this observation: “There seems to be some idea that under the plant law, the plant should be described in such a way that it could be reproduced by anyone after reading over the patent. The framers of this law recognized the futility of such a thing in the face of the part nature plays in the production of new plant varieties.” JPOS, Vol. XV, No. 10, at 753.

The fact that the ‘KORpancom’ plant could have been purchased by someone in some foreign country and asexually reproduced is not relevant. Asexual reproduction is not a “making” of a plant, it is simply the multiplication of an existing plant by taking a part of that plant and letting it continue to grow. *In re LeGrice* distinguished these processes:

“The rose breeder strives to produce by *sexual* propagation [sic] a rose having the desired characteristics, after which this particular rose with the desirable characteristics is further propagated by *asexual* methods in which all of the characteristics of that one rose plant, and only that plant, are transmitted to the new plants derived by cutting, etc.” *LeGrice* @ p. 937.

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<sup>1</sup> While many such studies undoubtedly are in progress, some idea of the possible additions to the knowledge of plant heredity is found in current seed catalogue offerings of peanut seeds which by atomic irradiation will produce plants in which the peanuts are produced above the ground. The chemical called colchicines also is widely used to modify genetic characteristics of seeds. Current studies to “break the chromosome code” may also add to the knowledge of plant breeders so that they may someday secure possession of a plant invention by a description in a printed publication as is now possible in other fields of invented effort.

The conclusion of the *LeGrice* Court is applicable here, and paraphrasing that conclusion it is submitted that the description of the 'KORpancom' rose in the cited publications, is incapable of placing that rose in the public domain by its description when interpreted in the light of the knowledge now possessed by plant breeders. The rose described in the appealed application is not, therefore, "described in a printed publication" within the meaning of 35 U.S.C. § 102(b).

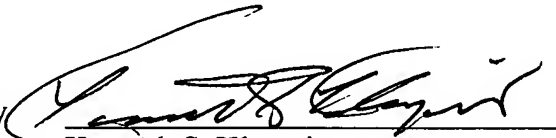
The decision in *In re Elsner*, 72 USPQ 1038, is clearly in conflict with *In re LeGrice*, *supra*, and its conclusion that the ability to asexually reproduce a rose on sale in a foreign country can create a 102(b) bar is clearly wrong.

Under the doctrine of *stare decisis*, the holding of the *LeGrice* Court should be followed and the subject application should be allowed and such action is respectfully requested.

Respectfully submitted,

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